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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,259	02/09/2004	Hitomi Makaanac	04329.3241	7154

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EXAMINER

BECK, ALEXANDER S

ART UNIT	PAPER NUMBER
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2629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/773,259

Applicant(s)

MAKANAE ET AL.

Examiner

Alexander S. Beck

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20050819, 20051117, 20060323.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statements (IDS) filed on August 19, 2005, November 17, 2005 and March 23, 2006 have been acknowledged and considered by the Examiner. Initialed copies of the PTO-1449 are included in this correspondence.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1 and 3-5** are rejected under 35 U.S.C. 102(e) as being anticipated by Oross et al. (U.S. Patent No. 6,757,002 B1, hereinafter OROSS).

As to independent **Claim 1**, OROSS teaches/suggests an electronic apparatus (12) in **Figures 1 and 9** comprising: a housing (e.g. housing of 12; 26/52) having an outer wall; a pointing device (16/18/20/22/24/28) having a flat input surface and contained in the housing such that the input surface is

Art Unit: 2629

placed on an inner surface of the outer wall of the housing; and an operation-area indicating sheet (66) removably provided on an outer surface of the outer wall of the housing at a position corresponding to at least part of the input surface of the pointing device (OROSS: col. 4, ln. 3 – col. 5, ln. 17; col. 9, ln. 21-38).

As to **Claim 3**, OROSS teaches/suggests wherein an exposed surface of the operation-area indicating sheet (66) is different in color from the outer surface of the outer wall (OROSS: col. 9, ln. 21-38).

As to **Claim 4**, OROSS teaches/suggests wherein an exposed surface of the operation-area indicating sheet is decorated with a pattern (OROSS: col. 9, ln. 21-38).

As to **Claim 5**, OROSS teaches/suggests in **Figures 1 and 9** wherein the outer surface of the outer wall has a palm rest (e.g. housing of **12; 26/52**), and the operation-area indicating sheet is provided on the palm rest (OROSS: col. 4, ln. 3-8; col. 9, ln. 21-38).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Art Unit: 2629

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 2 and 6-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Oross et al. (U.S. Patent No. 6,757,002 B1).

As to **Claim 2**, OROSS teaches/suggests in **Figures 1 and 9** wherein the outer surface of the outer wall has a sheet-containment depressed portion (e.g. depressed portion for receiving removable film **66**) at a position corresponding to at least part of the input surface (**20**) of the pointing device (**16/18/20/22/24/28**), the sheet-containment depressed portion has a base, and the operation-area indicating sheet (**66**) is removably stuck to the base of the sheet-containment depressed portion (e.g. removably stuck to protective sheet **26**) (OROSS: col. 4, ln. 38 – col. 5, ln. 17; col. 9, ln. 21-38).

OROSS does not disclose expressly in **Figures 1 and 9** wherein the sheet-containment depressed portion has a peripheral surface rising from a perimeter of the base.

However, OROSS discloses an additional exemplary embodiment in **Figure 7** wherein the sheet-containment depressed portion has a peripheral surface rising from a perimeter of the base. As can be seen, element **58** is an additional layer that is fastened to protective layer **26**. The fastening is achieved by having a wall portion **52** protruding from the plane of the protective layer **26** so as to form an overhang about the corner. This overhang serves to secure the additional layer **58** between the plane of the protective layer **26** and the wall portion **52**. Thus, the wall portion **52** immediately adjacent to and protruding from the protective layer **26** serving as a peripheral surface rising from a perimeter of the base.

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teachings of OROSS such that the operation-area indicating sheet (e.g. element 66; an additional layer fastened to the protective layer 26) was fastened to the protective layer as taught/suggested by OROSS in the exemplary embodiment illustrated in **Figure 7**. As such, the corner portions of the operation-area indicating sheet containing tabs that may be fastened to the protective layer by means of a peripheral surface rising from a perimeter of the base to serve as an overhang portion.

The suggestion/motivation would have been to secure an additional layer to the protective layer, in such a manner, so as to permit user interaction with the additional layer without accidentally removing the same from the protective layer. As one of ordinary skill in the art would appreciate from the illustration in **Figure 7**, this advantage is achieved as a result the corner portions of the additional layer containing tabs that may be fastened to the protective layer by means of a peripheral surface rising from a perimeter of the base to serve as an overhang portion.

As to **Claim 6**, the teachings of OROSS in **Figures 1 and 9**, as modified by the exemplary embodiment illustrated in **Figure 7** and as discussed with respect to Claim 2 above, teaches/suggests wherein the housing has an overhang edge portion at an opening end of the sheet-containment depressed portion, and the overhang portion overhangs to cover at least part of a perimeter portion of the operation-area indicating sheet.

For example, as can be seen in **Figure 7**, the housing (e.g. housing of 12; 26/52) has an overhang edge portion (e.g. the wall portion 52 immediately adjacent to and protruding from the protective layer 26) at an opening end of the sheet containment depressed portion (e.g. depressed portion for receiving removable film 66), and the overhang portion overhangs to cover at least part of a perimeter portion of the operation-area indicating sheet (66).

Art Unit: 2629

As to **Claim 7**, the teachings of OROSS in **Figures 1 and 9**, as modified by the exemplary embodiment illustrated in **Figure 7** and as discussed with respect to Claims 2 and 6 above, teaches/suggests wherein the outer surface of the outer wall has a finger recess, at a position corresponding to the sheet-containment depressed portion, for putting a finger on an edge of the operation-area indicating sheet when the operation-area indicating sheet is peeled off.

For example, as can be seen from **Figure 7**, the additional layer **58** is secured to the protective layer **26** by including a tabbed portion that is to be fixed in between an overhang portion at a corner of the outer surface of the outer wall and the protective layer **26**. To remove the additional layer **58** from the protective layer **26** would be inherently suggestive to one of ordinary skill in the art that the tabbed portion of the additional layer **58** must first be disengaged from the corner portion with the overhang.

Moreover, as can be seen from **Figures 1 and 9**, the electronic apparatus comprises at least 5 corners, each of which serve as a finger recess for putting a finger on an edge of the operation-area indicating sheet **66**. Therefore, when the exemplary embodiments of **Figures 1, 9 and 7** are combined together, to peel off the operation-area indicating sheet **66** would be inherently suggestive to one of ordinary skill in the art that the tabbed portions of the sheet **66** must first be disengaged from the corner portion with the overhang. This is accomplished by placing a finger on an edge of the sheet within any one of the 5 finger recess areas (i.e. placing a finger in close proximity to the tabbed portions of the operation-area indicating sheet **66** and applying a push/pull force so as to disengage the tabbed portion with the overhang portion).

As to **Claim 8**, the teachings of OROSS in **Figures 1 and 9**, as modified by the exemplary embodiment illustrated in **Figure 7** and as discussed with respect to Claims 2 and 6 above, teaches/suggests wherein the housing has a frame that fits into the sheet-containment depressed portion

Art Unit: 2629

along the peripheral surface of the sheet-containment depressed portion, and the overhang portion is provided to the frame.

For example, as can be seen in **Figure 7**, the housing has a frame (e.g. the wall portion **52** immediately adjacent to and protruding from the protective layer **26**) that fits into the sheet-containment depressed portion along the peripheral surface of the sheet-containment depressed portion, and the overhang portion is provided to the frame (e.g. the wall portion **52** immediately adjacent to and protruding from the protective layer **26** that serves to fasten the additional layer **58**).

As to **Claims 9 and 13**, the teachings of OROSS in **Figures 1 and 9**, as modified by the exemplary embodiment illustrated in **Figure 7** and as discussed with respect to Claims 2,6 and 7 above, teaches/suggests wherein the base of the sheet-containment depressed portion has four corner portions, and four overhang edge portions identical to the overhang edge portion are provided at positions corresponding to the four corner portions, respectively.

For example, as can be seen from **Figure 7**, the additional layer **58** is secured to the protective layer **26** by including a tabbed portion that is to be fixed in between an overhang portion at a corner of the outer surface of the outer wall and the protective layer **26**. The overhang edge portion is provided at a position corresponding to the corner portion of the protective layer **26**.

Moreover, as can be seen from **Figures 1 and 9**, the electronic apparatus comprises at least 5 corners at the base of the sheet-containment depressed portion. Applying the teachings of **Figure 7** into the exemplary embodiment of **Figures 1 and 9** results in at least four corner portions (e.g. five in this example) at the base of the sheet-containment depressed portion, wherein the four overhang edge portions identical to the overhang edge portion are provided at positions corresponding to the four corner portions, respectively.

As to **Claim 10**, OROSS teaches/suggests in **Figure 9** wherein the operation-area indicating sheet 66 is flexible (OROSS: col. 9, ln. 21-38).

As to **Claim 11**, the teachings of OROSS in **Figures 1 and 9**, as modified by the exemplary embodiment illustrated in **Figure 7** and as discussed with respect to Claims 2,6 and 7 above, teaches/suggests wherein the base of the sheet-containment depression portion has a side, and a finger recess is provided at a position corresponding to the side.

For example, as can be seen from **Figures 1 and 9**, the base of the sheet-containment depression portion (e.g. depressed portion for receiving removable film 66) has a side, and a finger recess 36 is provided at a position corresponding to the side.

As to **Claims 12 and 14**, the teachings of OROSS in **Figures 1 and 9**, as modified by the exemplary embodiment illustrated in **Figure 7** and as discussed with respect to Claims 2,6 and 7 above, teaches/suggests wherein the finger recess has a base situated at a lower level than an exposed surface of the operation-area indicating sheet (as evidenced by the fact that the operation-area indicating sheet 66 overlaps the base of the finger recess).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Donohue et al. (U.S. Patent No. 6,262,717 B1) discloses the structure of a touchpad assembly housing.

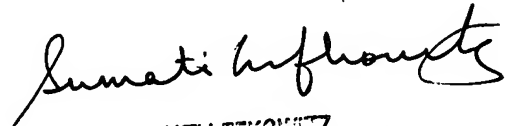
Art Unit: 2629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Alexander S. Beck** whose telephone number is **(571) 272-7765**. The examiner can normally be reached on M-F, 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Sumati Lefkowitz** can be reached on **(571) 272-3638**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

asb
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